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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,460	01/08/2002	Hartwig Schwier	P01,0299	4135
26574	7590	12/02/2005	EXAMINER	
SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			MILIA, MARK R	
		ART UNIT	PAPER NUMBER	
		2622		

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/936,460	SCHWIER ET AL.
	Examiner Mark R. Milia	Art Unit 2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 22-45 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 22-45 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 September 2005 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 9/8/05 and has been entered and made of record. Currently, claims 22-45 are pending.

Drawings

2. Applicant's amendment to the specification to insert missing reference characters has overcome the objection to the Drawings as cited in the previous Office Action. Therefore the objection has been withdrawn. Applicant's amendment to Fig. 9 to change reference character "56" to "62" does not overcome the objection to Fig. 9 as cited in the previous Office Action because no change has actually been made and the "EPE Print Processor" is still labeled as "56". Therefore the objection is maintained and repeated.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "56" has been used to designate both a "Spool File" in Fig.8 and an "EPE Print Processor" in Fig. 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is

being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. Applicant's amendment to the specification to correct minor informalities has overcome the objection to the specification as cited in the previous Office Action. Therefore the objection has been withdrawn.

Claim Rejections - 35 USC § 101

5. Applicant's amendment to claim 43 has rendered the claim statutory and has overcome the rejection as cited in the previous Office Action. Therefore the rejection has been withdrawn.

Response to Arguments

6. Applicant's arguments, see pages 14-15, filed 9/8/05, with respect to the rejection(s) of claim(s) 40 under 35 U.S.C. 102(b) have been fully considered and are

persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the current amendment to the claim and newly found prior art. The examiner agrees that the reference of Uematsu does not disclose marking a document and inserting variable data being performed within a computer system, as currently amended.

7. Applicant's arguments filed 9/8/05, with respect to the rejection(s) of claim(s) 22-39 and 43-44 under 35 U.S.C. 103(a) have been fully considered but they are not persuasive. In response to applicant's arguments regarding the rejection of claims 22, 43, and 44, wherein on page 16, the applicant asserts that the combination of Heiney and Snyders would not have been obvious because the teachings of high speed printing cannot be used in the field of low speed printing and that the MS Windows environment is suited only for low speed printing. The examiner disagrees with respect to the current claim language used in claims 22, 43, and 44. First, the claims lack any indication of whether the system is a high speed or low speed printing system. As such, the combination of Heiney and Snyders are an obvious combination as they both deal with formatting document data for subsequent printing. Secondly, the claims state that the computer system operates with a Windows or windows-like operating system. This statement is made in the preamble of the claims and never mentioned in the body of the claims and as such is not given any patentable weight. Further the recitation of the phrase windows-like can be interpreted to be any operating system that is in any way similar to MS Windows and the knowledge of MS Windows being best suited for low speed printing does not necessarily apply to a windows-like operating system.

8. Therefore, the rejection of claims 22-39 and 43-44, as cited in the previous Office Action, is maintained and repeated in this Office Action. The current amendments to claim 22 will be addressed in the following rejection (disclosed in the reference of Snyders, see columns 9-11) along with newly added claim 45.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 22-31, 33-39, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5983243 to Heiney et al. in view of U.S. Patent No. 5982996 to Snyders.

Regarding claim 22, Heiney discloses a method for transmission of data from a computer system that is operated with a Windows or windows-like operating system to an output device, comprising the steps of: generating a master document (see Fig. 3 and column 4 lines 21-67), logically linking a plurality of auxiliary documents with the master document by forming reference indices (see Fig. 3 and column 5 lines 12-20 and 38-49), sending the data of the auxiliary documents to the output device separated from data of the master document (see Fig. 3 and column 3 line 56-column 4 line 10), joining the data of the auxiliary documents with the data of the master document in the output device upon employment of the reference indices (see Fig. 3 and column 5 lines 57-61), generating a print job from an application program (see Fig. 3 and column 5 lines 63-64)

including: calling a printer driver first (see column 3 lines 61-66, reference states that the raster image processor translates the PDL document into printable dot patterns which is analogous to the function of a printer driver), setting settings of the appertaining printer supported by the called printer driver job-specifically (see column 4 lines 4-10 and 39-41), and enabling the print job, as a result whereof the data of at least one of the master document and of the auxiliary documents are generated (see Fig. 3 and column 5 lines 63-64).

Heiney does not disclose expressly generating a data stream in an enhanced metafile format, calling a converter unit by a print processor, said converter converting said enhanced metafile format into a print data format, controlling a conversion by said converter by predetermined parameters input via an input module, carrying out a check in a check step to see whether the respectively generated output format corresponds to a standard prescribed by the operating system, supplying the data, when there is correspondence, to a print processor located in a spooler and, when non-correspondence is found in the check step, are converted by an operating system-specific converter unit into an intermediate data stream that is further-processed via various output channels.

Snyders discloses generating a data stream in an enhanced metafile format (see column 10 lines 21-23, 45-46, and 56-63), calling a converter unit by a print processor, said converter converting said enhanced metafile format into a print data format (see column 9 lines 15-27 and 50-53, and column 10 line 15-column 11 lines 37), controlling a conversion by said converter by predetermined parameters input via an input module

(see Fig. 1 and column 9 lines 28-31 and 38-43), carrying out a check in a check step to see whether the respectively generated output format corresponds to a standard prescribed by the operating system (see column 7 lines 42-45 and column 8 lines 4-9) and supplying the data, when there is correspondence, to a print processor located in a spooler and, when non-correspondence is found in the check step, are converted by an operating system-specific converter unit into an intermediate data stream that is further-processed via various output channels (see column 6 line 60-column 7 line 15, column 7 lines 39-41, and column 8 lines 3-9, 14-35, and 51-54).

Regarding claims 43 and 44, Heiney discloses a method and computer program on a computer readable medium for transmission of data from a computer system that is operated with a Windows or windows-like operating system to an output device, comprising the steps of: generating a master document (see Fig. 3 and column 4 lines 21-67), logically linking a plurality of auxiliary documents with the master document by forming reference indices (see Fig. 3 and column 5 lines 12-20 and 38-49), sending the data of the auxiliary documents to the output device separated from data of the master document (see Fig. 3 and column 3 line 56-column 4 line 10), joining the data of the auxiliary documents with the data of the master document in the output device upon employment of the reference indices (see Fig. 3 and column 5 lines 57-61), generating a print job from an application program (see Fig. 3 and column 5 lines 63-64) including: calling a printer driver first (see column 3 lines 61-66, reference states that the raster image processor translates the PDL document into printable dot patterns which is analogous to the function of a printer driver), setting settings of the appertaining printer

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supported by the called printer driver job-specifically (see column 4 lines 4-10 and 39-41), and enabling the print job, as a result whereof the data of at least one of the master document and of the auxiliary documents are generated (see Fig. 3 and column 5 lines 63-64).

Heiney does not disclose expressly carrying out a check in a check step to see whether the respectively generated output format corresponds to a standard prescribed by the operating system, supplying the data, when there is correspondence, to a print processor located in a spooler and, when non-correspondence is found in the check step, are converted by an operating system-specific converter unit into an intermediate data stream that is further-processed via various output channels.

Snyders discloses carrying out a check in a check step to see whether the respectively generated output format corresponds to a standard prescribed by the operating system (see column 7 lines 42-45 and column 8 lines 4-9) and supplying the data, when there is correspondence, to a print processor located in a spooler and, when non-correspondence is found in the check step, are converted by an operating system-specific converter unit into an intermediate data stream that is further-processed via various output channels (see column 6 line 60-column 7 line 15, column 7 lines 39-41, and column 8 lines 3-9, 14-35, and 51-54).

Regarding claim 45, Heiney discloses a method for transmission of data from a computer system that is operated with a Windows or windows-like operating system to an output device, comprising the steps of: generating a master document (see Fig. 3 and column 4 lines 21-67), logically linking a plurality of auxiliary documents with the

master document by forming reference indices (see Fig. 3 and column 5 lines 12-20 and 38-49), sending the data of the auxiliary documents to the output device separated from data of the master document (see Fig. 3 and column 3 line 56-column 4 line 10), joining the data of the auxiliary documents with the data of the master document in the output device upon employment of the reference indices (see Fig. 3 and column 5 lines 57-61), generating a print job from an application program (see Fig. 3 and column 5 lines 63-64) including: calling a printer driver first (see column 3 lines 61-66, reference states that the raster image processor translates the PDL document into printable dot patterns which is analogous to the function of a printer driver), setting settings of the appertaining printer supported by the called printer driver job-specifically (see column 4 lines 4-10 and 39-41), and enabling the print job, as a result whereof the data of at least one of the master document and of the auxiliary documents are generated (see Fig. 3 and column 5 lines 63-64).

Heiney does not disclose expressly generating a data stream in an enhanced metafile format, calling a converter unit by a print processor, said converter converting said enhanced metafile format into a print data format, controlling a conversion by said converter by predetermined parameters input via an input module, carrying out a check in a check step to see whether the respectively generated output format corresponds to a standard prescribed by the operating system, supplying the data, when there is correspondence, to a print processor located in a spooler.

Snyders discloses generating a data stream in an enhanced metafile format (see column 10 lines 21-23, 45-46, and 56-63), calling a converter unit by a print processor,

said converter converting said enhanced metafile format into a print data format (see column 9 lines 15-27 and 50-53, and column 10 line 15-column 11 lines 37), controlling a conversion by said converter by predetermined parameters input via an input module (see Fig. 1 and column 9 lines 28-31 and 38-43), carrying out a check in a check step to see whether the respectively generated output format corresponds to a standard prescribed by the operating system (see column 7 lines 42-45 and column 8 lines 4-9) and supplying the data, when there is correspondence, to a print processor located in a spooler (see column 6 line 60-column 7 line 15, column 7 lines 39-41, column 8 lines 3-9, 14-35, and 51-54, column 9 lines 15-43, and column 10 line 15-column 11 line 37).

Heiney & Snyders are combinable because they are from the same field of endeavor, formatting document data for subsequent printing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the printer driver switching to allow distribution of print jobs to an output device of Snyders with the system of Heiney.

The suggestion/motivation for doing so would have been to allow a plurality of different types of printers to output the same document data that is created by a user at a personal computer or workstation regardless of the format of the data in which the printer is capable of handling.

Therefore, it would have been obvious to combine Snyders with Heiney to obtain the invention as specified in claims 22 and 43-45.

Regarding claim 23, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses storing the data of the auxiliary documents in the output device (see column 3 line 66-column 4 line 10, reference shows the storage of documents being located in a print server that is attached to the printer).

Regarding claim 24, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses joining the data of the master document with the data of the auxiliary documents for output of individual documents (see column 5 lines 52-65).

Regarding claim 25, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses attaching the auxiliary documents to at least one arbitrary regions of the first document at a beginning of the output (see column 5 lines 10-21).

Regarding claim 26, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses controlling the referencing in a windows systems environment or in a windows-like system environment via data that are input via a user interface (see Figs. 1 and 2, column 3 lines 25-43, and column 4 lines 21-34).

Regarding claim 27, Heiney and Snyders disclose the system discussed in claim 26, and Heiney further discloses whereby the referencing ensues in a converter unit that converts an enhanced metafile data stream into a print data stream of a printer language (see column 4 line 55-column 5 line 29).

Regarding claim 28, Heiney and Snyders disclose the system discussed in claim 27, and Snyders further discloses whereby the converter unit collaborates with a print

processor and a port monitor of a spooler (see column 8 lines 59-67 and column 9 lines 18-27).

Regarding claim 29, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses specifying the area of the master document wherein a respective auxiliary document is linked with the master document (see column 5 lines 37-49).

Regarding claim 30, Heiney and Snyders disclose the system discussed in claim 29, and Heiney further discloses wherein said specifying step specifies a page region (see column 5 lines 37-49).

Regarding claim 31, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses indicating whether an auxiliary document is one of an overlay and a watermark document (see column 5 lines 37-49, reference states that a bookticket is created that instructs the collator how to merge the variable data with the fixed data form and one way in which that is accomplished is by overlaying the variable data onto the fixed data, the reference also states this in claim 14, therefore the reference teaches overlaying variable data).

Regarding claim 33, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses wherein said output device is a printer device (see Figs. 1 and 3, column 4 lines 1-10, and column 5 lines 63-64).

Regarding claim 34, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses transmitting an auxiliary document to the output device

in the PCL print data language (see column 4 lines 37-39, reference states the use of a PostScript or other similar PDL, of which PCL is a part of).

Regarding claim 35, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses transmitting an auxiliary document to the output device in the Postscript print data language (see column 4 lines 37-39).

Regarding claim 36, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses transmitting an auxiliary document to the output device in the IPDS print data language (see column 4 lines 37-39, reference states the use of a PostScript or other similar PDL, of which IPDS is a part of).

Regarding claim 37, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses transmitting an auxiliary document to the output device in the LCDS print data language (see column 4 lines 37-39, reference states the use of a PostScript or other similar PDL, of which LCDS is a part of).

Regarding claim 38, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses wherein an auxiliary document contains graphics information (see column 4 lines 39-41).

Regarding claim 39, Heiney and Snyders disclose the system discussed in claim 22, and Heiney further discloses 39. A method as claimed in claim 38, wherein said graphics information is one of an image datafile and a diagram (see column 4 lines 39-41).

11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heiney and Snyders as applied to claim 22 above, and further in view of U.S. Patent No. 6473892 to Porter.

Heiney and Snyders do not disclose expressly wherein an auxiliary document is a macro datafile.

Porter discloses wherein an auxiliary document is a macro datafile (see Fig. 2 and column 8 line 46-column 9 line 13).

Heiney, Snyders, & Porter are combinable because they are from the same field of endeavor, formatting document data for subsequent printing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the macro datafile as described by Porter with the system of Heiney and Snyders.

The suggestion/motivation for doing so would have been to provide greater flexibility and create more options as a macro can contain a plurality of objects and properties that can be made of use in the merging of data.

Therefore, it would have been obvious to combine Porter with Heiney and Snyders to obtain the invention as specified in claim 32.

12. Claims 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uematsu in view of Heiney and U.S. Patent No. 5742879 to Altrieth III.

Regarding claim 40 discloses Uematsu discloses a method for transmission of data from a computer system that to an output device, comprising the steps of:

providing a master document having a variable data area and a static data area (see Figs. 1 and 4 and column 5 lines 10-16), inserting variable data into the variable data area, as a result whereof a serial data stream with individual documents having variable data and static data arises (see Fig. 1 and column 6 lines 7-67), transmitting the variable data separated from the static data from the first individual document to the output device (see Fig. 1A and column 6 lines 41-63), storing the static data of the first individual document in the output device (see Fig. 3 and column 5 lines 3-19), the static data of following individual documents are not transmitted to the output device (see Fig. 1 and column 9 lines 6-31), and joining the variable data in turn with the stored static data individual document by individual document in the output device, wherein said steps of storing and joining are performed within an output device (see Fig. 1 and 10 and column 9 lines 6-31).

Uematsu does not disclose expressly marking the variable data area, wherein said step of providing the master document and said step of marking and said step of inserting variable data are performed within a computer system, and separating the variable data from the serial data stream from the static data on a basis of the marking.

Heiney discloses wherein said step of providing the master document and said step of marking and said step of inserting variable data are performed within a computer system (see Fig. 3, column 4 lines 20-67, and column 5 lines 5-29) and separating the variable data from the serial data stream from the static data (see Fig. 3, column 3 line 56-column 4 line 10, and column 5 lines 12-20 and 37-49).

Altrieth discloses marking the variable data area (see Figs. 1A-D, column 5 lines 9-20, and column 9 lines 34-38).

Uematsu, Heiney, & Altrieth are combinable because they are from the same field of endeavor, printing having static and variable data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the marking of the variable data are as described by Altrieth and the processing of the master document within a computer system as described by Heiney with the system of Uematsu.

The suggestion/motivation for doing so would have been to clearly locate variable data areas and increase printing speed and efficiency by allowing a computer system to process most of the document.

Therefore, it would have been obvious to combine Heiney and Altrieth with Uematsu to obtain the invention as specified in claim 40.

Regarding claim 41, Uematsu, Heiney, and Altrieth disclose the system discussed in claim 40, and Altrieth further discloses wherein said marking step of the variable data region ensues by a visually perceptible identification (see Figs. 1A-D, column 5 lines 12-20, and column 9 lines 34-38).

13. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uematsu, Heiney, and Altrieth in view of U.S. Patent No. 5649024 to Goldsmith.

Uematsu, Heiney, and Altrieth do not disclose expressly wherein said marking step of the variable data region ensues chromatically.

Goldsmith discloses wherein said marking step of the variable data region ensues chromatically (see column 6 lines 51-57 and column 7 lines 24-35, 48-52, and 61-67).

Uematsu, Heiney, Altrieth, & Goldsmith are combinable because they are from the same field of endeavor, merging and manipulation of document data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the color highlighting of originally black text as described by Goldsmith with the system of Uematsu, Heiney, and Altrieth.

The suggestion/motivation for doing so would have been to allow desired text to stand out in a document that has been created from merging text or graphic data with a master document.

Therefore, it would have been obvious to combine Goldsmith with Uematsu, Heiney, and Altrieth to obtain the invention as specified in claim 42.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
Examiner
Art Unit 2622

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